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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	MATSUMOTO, et al.	Docket No.	Q82169
Appln. No.	10/710,297	Group Art Unit	2853
Confirmation No.	4296	Examiner	Blaise L. Mouttet
Filed	June 30, 2004		
For:	INK CARTRIDGE		

PETITION TO WITHDRAW FINALITY UNDER 37 C.F.R. § 1.181

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits that the Final Office Action dated February 23, 2005, improperly has been made final and thus respectfully solicits withdrawal of the finality of the Office Action.

Specifically, the Examiner sets forth at least one new ground of rejection that was not necessitated by Applicant's amendments. Applicant submits that *independent* claim 1 is still in its original form, and thus, the current rejection of such claim under 35 U.S.C. § 103 (a) in view of Ujita et al. (US 5,506,611) and Hirst et al. (US 5,930,553) is not necessitated by amendment (See MPEP § 706.07(a)). As such, the current rejection under 35 U.S.C. § 103(a), is improperly made final (see rejection of claims 1, 2 and 8 on pg. 5 of the February 23, 2005 Office Action).

In further detail, the Ujita reference is a newly cited reference. Accordingly, claim 1, which was previously *unamended*, is being rejected under new grounds of rejection in the current Office Action. As set forth in MPEP § 706.07(a), "a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information

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disclosure statement filed under 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.” (emphasis added)

In view of the above, Applicant submits that the use of Ujita, as a newly cited reference, to reject recitations of the unamended independent claim 1, requires the current Office Action to be made non-final.

On March 2, 2005, the undersigned contacted the Examiner to request that the Examiner reconsider the finality of the outstanding Office Action. The Examiner maintained that the newly added claim 8 necessitated the new ground of rejection of claim 1. However, Applicant submits that such course of action is contrary to the teachings of the MPEP, as set forth above, and is in error. For example, rather than combining the Ujita reference with the references already of record in the previous rejections of claim 1 (i.e., Murray, Hirst and Childers), and using Ujita *solely* for the added limitations of new claim 8, the Examiner uses Ujita as a *primary* reference to reject features recited in the unamended independent claim 1, as well as for new claim 8 (see pg. 6 of Office Action) (i.e., in order for the finality to be proper, the Examiner could have rejected claim 8 in view of Murray, Hirst and Ujita, or Childers, Hirst and Ujita, and used the teachings of Ujita solely for the features of claim 8). Therefore, it is the use of the Ujita reference, in regard to the features of claim 1, that Applicant believes to be improper if the Office Action is to be made final.

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Since an agreement as to the finality of the Office Action was not reached, Applicant submits this petition. The information and arguments presented above duplicate the substance of the interview and constitute a summary thereof.

For the reasons discussed above, Applicant requests that the finality of the February 23, 2005 Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: March 4, 2005